

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Baeschlin et al.

Art Unit: 1621

Examiner: Ex. Kumar

APPLICATION NO: 10/579,427

FILED: 05/12/2006

FOR: Organic Compounds

**MS: General**

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

**PETITION REGARDING PATENT TERM ADJUSTMENT UNDER C.F.R. §1.705(b)**

Sir:

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for a patent term adjustment under 35 U.S.C. § 154(b) of greater than 465 days. This application is being filed with the payment of the issue fee, as required by 37 C.F.R. § 1.705 (b).

**I. Fee**

As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a request to charge Deposit Account No. **50-4409** for \$ 200.00 to cover the required fee (as defined in 37 C.F.R. § 1.18(e)). Please charge any deficiencies or any additional fees due in response to this request to Deposit Account **50-4409**.

**II. Statement of the Facts Involved**

**A. Correct Patent Term Adjustment**

The Notice of Allowance, which was mailed on March 13, 2009, indicated a preliminary Patent Term Adjustment of 465 days.

Patentee agrees with the calculation as calculated; however the post 3 year (B) time period started May 12, 2009. Therefore, an additional amount of Patent Term Adjustment is required by law to be calculated between the issue fee payment and grant.

### **Case Law**

In *Wyeth v. Dudas*, 2008 U.S. Dist. LEXIS 76063 (D.D.C. 2008), the District Court of the District of Columbia addressed the United States Patent and Trademark Office (USPTO) interpretation of 35 U.S.C. § 154(b)(2). The Court granted summary judgment in favor of Wyeth, determining that the USPTO misconstrued the first sentence of 35 U.S.C. § 154(b)(2)(A), and as a result, improperly denied Wyeth a portion of patent term to which Wyeth was entitled under 35 U.S.C. § 154.

In the opinion, the Court stated that "the PTO's view is that any administrative delay under § 154(b)(1)(A) overlaps any 3-year maximum pendency delay under § 154(b)(1)(B): the applicant gets credit for 'A-delay' or for 'B delay,' whichever is larger, but never A + B." However, Plaintiff Wyeth argued that the § 154(b)(1)(A) and § 154(b)(1)(B) period overlap only if they occur on the same calendar day or days. The Court determined that Wyeth's construction of § 154(b)(2)(B) was correct.

Simply put, the holding of the Court is that the excluded overlap recited in the first sentence of 35 U.S.C. § 154(b)(2)(A) only occurs if a 35 U.S.C. § 154(b)(2)(A) period and a 35 U.S.C. § 154(b)(2)(B) period run concurrently. As such, a patent holder is entitled to recoup the 35 U.S.C. § 154(b)(2)(A) period that falls outside of the 35 U.S.C. § 154(b)(2)(B) period in addition to the 35 U.S.C. § 154(b)(2)(B) period itself.

### **Relevant Dates**

The above identified application has a 35 U.S.C. § 371 filing date of May 12, 2009.

A Notice of Allowance was mailed March 13, 2009.

The initial PTO adjustment based on delay under 35 U.S.C. § 154(b)(2)(A) is 465 days.

The issue fee is being paid on June 12, 2009 in a paper accompanying the instant petition, within the 3 months provided by 35 U.S.C. § 154(b).

The initial 35 U.S.C. § 154(b)(2)(B) period for the instant application began on May 12, 2009 (three years after the filing date of May 12, 2006) and will end on the date of issuance. The initial 35 U.S.C. § 154(b)(2)(B) period running from May 12, 2009 until payment of the issue fee (June 12, 2009) is 31 days. The reduction in term adjustment due to applicant delay is 0 days, resulting in an initial patent term adjustment of 31 days under 35 U.S.C. § 154(b)(2)(B).

The time between Issue Fee Payment (June 12, 2009) and Grant will fall within 35 U.S.C. § 154(b)(2)(B) delay; therefore, when additional Patent Term Adjustment is required upon grant.

The Patent Term Adjustment should be  $465 + 31 = 496$  + calculated time from fee payment to grant.

The initial PTA printed on the Notice of Allowance is only 465 days, which the USPTO is presumed to have calculated without considering that the 3 year threshold would happen on May 12, 2009. Applicants, therefore, respectfully request reconsideration of the initial PTA calculation.

**B. Terminal Disclaimer**

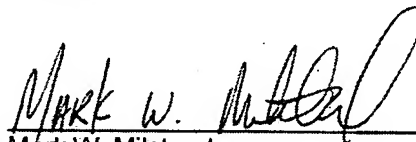
The above-identified patent is not subject to a Terminal Disclaimer.

**C. Reasonable Efforts**

Any applicant delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Respectfully submitted,

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Date: June 12, 2009